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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,288	02/17/2000	Jin-Su Park	P51671RE	7560
7590 10/09/2008 Robert E. Bushnell and Law Firm 1522 K Street, N.W. Suite 300 Washington, DC 20005-1202				
EXAMINER ISSING, GREGORY C				
ART UNIT 3662		PAPER NUMBER		
MAIL DATE 10/09/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/506,288

Applicant(s)

PARK, JIN-SU

Examiner

Gregory C. Issing

Art Unit

3662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

1. In view of the applicant's failure to file a compliant brief within the time prescribed by 37 CFR 41.37(a)(1) in response to the Notice of Non-Compliant Appeal Brief (37 CFR 41.37), filed 11/13/2007, the appeal is dismissed. See MPEP 1215.04.

2. **This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested.** An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

3. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,719,618 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

4. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

5. **Claims 1-59 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251.** See 37 CFR 1.175. The nature of the defect is set forth above, more particularly, claims in the application have been amended subsequent to the last declaration filed (5/7/02).

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

6. See MPEP § 1414.01.

7. The following grounds of rejection are maintained from the previous Office Actions.

35 USC 112, first paragraph

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Enablement Requirement

9. **Claims 20 and 44-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains,

or with which it is most nearly connected, to make and/or use the invention. The rejections are set forth in paragraphs 15-19 of the Office Action filed 2/21/06.

10. In Section X, C., of the applicant's response filed 10/24/05, the applicant argues inconclusively for overcoming the rejection under 35 USC 112, first paragraph, with respect to the enablement requirement.

11. With respect to claim 20, the applicant's argument that there is nothing in the language of the claims that requires "making a subjective evaluation of the video image" since content extends beyond a "video image" and may have little relevance to what the video image portrays. This argument is not convincing and in contradictory to the claim language which states "making a subjective evaluation of content portrayed by a first video signal". The applicant's argument that the specification teaches "the main advantage of this invention lies in the fact that it can bar unauthorized people from watching video programs" says nothing with respect to an enabling disclosure for "making a subjective evaluation of content portrayed by a first video signal" nor "generating a code in dependence upon said evaluation." The mere allegation that an advantage may be had from the invention does not fulfill the requirements of 35 USC 112, first paragraph. The applicant's remarks in the section starting "Fourth . . ." fails to provide any showing of the support for an enabling disclosure. The allegation that the issues raised by the Office are baseless is argumentative and fails to cure the deficiencies.

12. With respect to claim 47, the rejection is not overcome as the applicant has failed to show where a teaching is provided in the original specification for comparing an entered secret code to a stored code and subsequently locking audio while releasing muting of the video. The rejection

clearly sets forth what the Office deems is not supported, see sentence 2 of paragraph 17 of the last Office Action.

13. With respect to claims 44-58, the applicant's argument that the purported language was not before the Board is incorrect and not germane to the issue. Regarding the applicant's assertion that the use of the adverb "only" is not present in the claims is not germane to the rejection as the Office Action clearly sets forth that it is the view of the Office that the Board decided that the claimed operation was performed during a standby mode and that the claims as presented are not. As the Board's opinion expressed the patentability of the claims over the art in view of the operation during standby and not with respect to operation in a power on mode, the claimed subject matter for operating first and a second lock key operation having video information generated and displayed therebetween is not supported by the specification as originally filed. The applicant's argument that steps 12, 16 and 17 of Figure 1 provide support is not convincing since no second lock key signal operation is shown therein.

Written Description Requirement

14. **Claims 20 and 44-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

15. The rejection is set forth in paragraphs 20-23 of the Office Action of 2/21/06.

16. With respect to the rejection of claims 20 and 44-58 under 35 USC 112, first paragraph as failing to comply with the written description requirement, the applicant fails to provide any

response thereto, simply repeating the Office's rejection in Section X, D in the remarks filed 10/24/05. The rejection is therefore maintained.

35 USC 112, second paragraph

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 47, 50-52 and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

19. The rejection is set forth in paragraphs 24-28 of the Office Action filed 2/21/06.

20. With respect to the rejection of claims 44-58 under 35 USC 112, second paragraph, the applicant's arguments in Section X., E. of the remarks filed 10/24/05, are considered with the following remarks.

Regarding claim 44, the amendment overcomes the previous rejection.

Regarding claim 47, the applicant provides no response. The rejection is maintained.

Regarding claims 50-52 and 58, the applicant's allegation that the relationship between "the second lock key data" and "reference" is well-defined, precise and inescapable in its meaning and clarity, is unsupported, repetitive, and not convincing. The rejection is maintained.

35 USC 103

21. Claims 9-13, 15-19, 24, 25, 29-33, 35-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rew (5,033,085) in view of Inagaki et al (4,896,354).

22. The rejection is substantially set forth in a previous Office Action filed 6/24/05, pages 4-9, and summarized in the last Office Action (2/21/06) in paragraphs 31-32.

23. The rejection of claims 9-13, 15-19, 24, 25, 29-33, and 35-43 under 35 USC 103(a) as being unpatentable over Rew in view of Inagaki et al is maintained as the applicant has not provided any arguments and has merely reiterated the Office's rejections/response from the previous Office Action as found in Section F of the Applicant's response. The Office's arguments in the prosecution history are additionally maintained.

35 USC 251

24. **Claims 20, 44, 45, 47-51 and 54-58 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.** See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

25. The rejection regarding claim 20 is set forth in the Office Action filed 2/21/06 in paragraphs 42-51 and the rejection regarding claims 44, 45, 47-51 and 54-58 are set forth in paragraphs 53-55 of the Office Action filed 2/21/06.

26. The rejection of claims 20, 44, 45, 47-51 and 54-58 under 35 USC 251 as being improper recapture of broadened claimed subject matter is maintained since the applicant has merely reiterated the Office's opinion from the previous Office Action as found in Sections G and H of the Applicant's response.

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory C. Issing/
Primary Examiner
Art Unit 3662

gci